

RECEIVED
CENTRAL FAX CENTER

Application No.: 10/748,784

7 NOV 30 2006

Docket No.: 146712015100

REMARKS

Claims 1-24 were pending. Claims 11-20 were previously withdrawn in response to restriction requirements. The present response cancels claim 24, and amends claims 1, 21 and 23. Therefore, claims 1-10 and 21-23 are presently under consideration. The present response adds no new matter. The amendments do not change the species on which the claims read. Entry of this response is respectfully requested.

Claims 21-24 are rejected under 35 U.S.C. § 112, first and second paragraphs, based on rationales described below, which are each addressed in turn.

The rejection states that "'the outer cylindrical surface' lacks antecedent basis, and what is it the outer surface of?" Applicants respectfully submit that the amendments to claims 21 and 23 clarify the subject matter by making it clear that the outer cylindrical surface of the previously pending claim 1 was a portion of the hub.

Applicants submit that the "annular surface" recitations of claim 21 complied with the requirements of 35 U.S.C. § 112, since claim 21 recited: "the hub comprising an annular surface...the sleeve comprising an annular surface." As such, one of ordinary skill would have understood that these annular surfaces were respectively portions of the hub and sleeve, as also illustrated and described in the specification. Nevertheless, Applicants have amended claims 21 and 23 to further clarify these aspects.

Claims 1-6, 8-10, and 21-23 were rejected under 35 U.S.C. § 102(e) based on Heine '540 (Heine).

The rejection states that Heine discloses all the limitations of claims 1 and 21. In particular, the rejection states, "[s]ee front page Fig. and capillary near 104." (Office Action 8/15/06 at 3.)

Claim 1 and 21 have been amended to further clarify that the second gap/second gap region includes a second end that is exposed to the ambient environment, as illustrated, for example,

sf-2217168

Application No.: 10/748,784

8

Docket No.: 146712015100

in Figure 4. By contrast, Heine illustrates a bearing system where a second gap is sealed by a "counterplate 58...resting on and pressed against an annular ring section 60 of the sleeve 54. The outer diameter of the counterplate 58 is pressed inside shoulder 62 of the sleeve 54." (4:60-65.) Because the counterplate is pressed into the sleeve 54, the counterplate is stationary with respect to the sleeve 54, and does not provide an opening to the ambient environment as recited by claim 1 and 21.

Applicants also note that further evidence of the lack of such an opening in the second gap is that Heine provides a ring 60, and an O-ring 66 "impressed in the recess 65 [that] will prevent any such fluid motion from passing beyond the edges of the counterplate and working its way up between the shoulder and the counterplate and out into the surrounding atmosphere. (6:1-10.) The presence of this structure in Heine evidences that the second gap of Heine is not open at a second end to the ambient environment. As such, Applicants submit that the cited portions of Heine do not teach or suggest the structure of claims 1 and 21.

Further, Applicants also note that the rejection states that structures according to various claims in the present application are obvious either based on official notice of common knowledge in the art or engineering design choice. However, the art of record shows that the second end of a second gap was sealed by a press-fitted counterplate, not by the structure recited in claims 1 and 21. Therefore, Applicants respectfully submit that the present record contains no evidence to show that it was common knowledge to provide a structure according to the pending claims, nor does the record contain evidence that providing such a structure would be a matter of engineering design choice.

Instead, the record contains evidence to the contrary. As such, Applicants respectfully submit that structures of the pending claims are not "capable of instant and unquestionable demonstration as being well-known" as is required to maintain a rejection based on common knowledge. *In re Ahlbert*, 424 F.2d 1088, 1091 (CCPA 1970.) Because there is evidence in the record showing that the presumed closest art is structurally different from the present claims, the Examiner is respectfully requested to provide evidence proving the instant and unquestionable

sf-2217168

Application No.: 10/748,784

9

Docket No.: 146712015100

notoriety of the limitations of the present claims for which the Examiner is relying on common knowledge or engineering design choice.

Applicants also respectfully traverse the Examiner's assessment that the present claims "solve(s) no stated problem insofar as the record is concerned." As shown above, however, Applicants at least have provided a novel way to seal a bearing, which is a problem of concern in the art.

Applicants further note that *In re Kuhle* is distinguishable from the present facts at least because that case involved a combination of references that taught all the structure of the claims. Here, the evidence in the rejections does not teach all the structure in the claims.

The remaining claims under consideration depend either from claim 1 or 21 and benefit from the patentability of those claims. Applicants therefore respectfully request withdrawal of the rejections against the claims under consideration.

sf-2217168

Application No.: 10/748,784

10

Docket No.: 146712015100

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 146712015100. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: November 30, 2006

Respectfully submitted,

By 

Michael S. Garrabrants

Registration No.: 51, 230

MORRISON & FOERSTER LLP

425 Market St.

San Francisco, CA 94105

415-268-6824

sf-2217168